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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/772,622

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EXAMINER

LAVILLA, MICHAEL E

ART UNIT

PAPER NUMBER

1794

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/772,622	<b>Applicant(s)</b> GERMANO, VICTOR V.	
	<b>Examiner</b> Michael La Villa	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2007 and 14 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 1-7,9,10,13-30 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8, 11, 12, and 31-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of organofunctional silane binder species in the reply filed on 20 December 2007 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claim 38 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 20 December 2007.

### ***Claim Objections***

3. Claims 31-37 are objected to because of the following informalities: The preamble of these claims should read "anti-corrosion coating system" as this is what is claimed in previous Claim 8. The objection applies to withdrawn Claim 38 as well. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:
5. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
6. Claims 33-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding Claims 33-35, applicant has not apparently described how these claims are supported by the originally filed Specification. The Specification at page 5 uses similar language to that of these claims. However, this text appears to refer to the composition used to form the first layer, as opposed to the composition of the formed first layer. Unlike the composition of the formed layer, the forming composition would also contain solvent. Hence, it is unclear where applicant characterizes the composition of the formed layer in the originally filed Specification in a manner analogous to that now claimed.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 8, 11, 12, and 31-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guhde et al. EP 0808883 for the reasons of record in the Office Action mailed on 15 June 2007. With respect to Claims 33 and 35, Guhde at page 4 uses identical language to that of these claims, notwithstanding reference to the coating composition as opposed to the composition of the formed coating.
10. Claims 31, 32, 34, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maze et al. USPA 2002/0119337. Maze et al. teaches coating a metal substrate with a silane binder coating composition that contains zinc and aluminum metal flakes in the claimed relative amounts. Maze et al. teaches that the coated substrate may have a top coat conferred on it, including top coat comprised of epoxies, although Maze et al. may not exemplify such an epoxy-containing top coat. See Maze et al. (Abstract; col. 5, line 26 through col. 6, line 15; col. 11, lines 25-43; col. 14, lines 10-32; and col. 17, line 39 through col. 19, line 25). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply an epoxy containing top coat to the coated substrate of Maze et al., as Maze et al. suggests that effective top coat protection may be provided in this manner. Epoxy materials are quintessential thermoset materials. The epoxy paint of Maze et al. would be expected to be indistinguishable from the claimed powder coat composition since, once cured, the powder origins would be expected to be untraceable.

***Response to Amendment***

11. In view of applicant's amendments and arguments, applicant traverses the section 112, second paragraph rejection of the Office Action mailed on 15 June 2007. Rejection is withdrawn.
12. In view of applicant's amendments and arguments, applicant traverses the section 103 rejection over Guhde of the Office Action mailed on 15 June 2007. While applicant acknowledges that Guhde suggests using epoxy paint top coat, applicant argues that Guhde does not teach a powder coat layer, nor a thermoset. The paint layer of Guhde would be expected to be indistinguishable from one that had been formed by powder coat application. Applicant's claim is not understood to require a second layer having actual powder containing material. Rather, the second layer is understood to have been derived from such a powder containing material. Applicant has provided no evidence or argument as to why Guhde's paint layer, which could have been a powder coat composition, but not necessarily, is nevertheless necessarily different from that claimed in terms of final composition and/or structure. With respect to Claims 11 and 12, epoxy materials are quintessential thermoset materials, which is what these claims require. Rejections are maintained.
13. Regarding withdrawn Claim 38, the text of this claim, as presented in the Response of 20 December 2007, does not comport with the text of the same claim in the Response of 14 September 2007. As a result the claim status

identifier in the Response of 20 December 2007 must be incorrect or the claim text is incorrect. Applicant should reconcile this discrepancy.

***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
15. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Monday through Friday.
17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael La Villa/  
Michael La Villa  
Primary Examiner, Art Unit 1794  
16 March 2008